

Amendment and Response

Applicant: Darrel Bloomquist et al.

Serial No.: 10/668,442

Filed: Sept. 23, 2003

Docket No.: 10013887-3

Title: METHOD AND ARTICLE FOR CONCENTRATING FIELDS AT SENSE LAYERS

REMARKS

This Amendment is responsive to the Office Action mailed April 27, 2004, in which claims 1, 2, 8, 9, 12-16, 19-21, 46-48 and 53-59 were rejected, claims 49-52 were allowed, and claims 10 and 11 were objected to. With this Response, claim 1 has been amended. Claims 1, 2, 8-16, 19-21 and 46-59 remain pending in the application and are presented for reconsideration and allowance.

Examiner's Amendment

The Examiner's Amendment to page 1 of the application, inserting related U.S. application history, is acknowledged and agreed to by the Applicants.

Claim Rejections under 35 U.S.C. § 112

Claims 2, 12, 47, 53 and 58 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 2, the term "the layer of magnetic material" was found to lack proper antecedent basis. Similarly, in claim 12, line 1, the term "the magnetic material" was found to lack proper antecedent basis. In response, claim 1, from which claims 2 and 12 depend, has been amended to specify "the cladding layer including a layer of magnetic material" so as to provide proper antecedent basis to both claims 2 and 12. Accordingly, withdrawal of the rejection of claims 2 and 12 is respectfully requested.

In claims 47, 53 and 58, the phrase "a minimum feature size of a lithography process used to form the magnetic memory device" was found to be indefinite, as the resulting claim is said to fail to clearly set forth the metes and bounds of the patent protection desired.

The Examiners rejection of claims 47, 53 and 58 is respectfully traversed. The 35 U.S.C. §112, second paragraph, requirement that the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant is an objective requirement. The definiteness requirement is evaluated in the context of whether the scope of the claim is clear to a person possessing the ordinary level of skill in the pertinent art. MPEP 2171. The Examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness." MPEP

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2173.02. Definiteness of claim language must be analyzed in light of (a) the content of the particular application disclosure; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP 2173.02. The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. §112, second paragraph. *Seattle Box Co., v. Industrial Crating & Packing, Inc.*, F.2d 818, 221 USPQ 568 (Fed. Cir 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification. MPEP 2173.05(b).

The present application, from page 11, line 5 through page 12, line 8, with reference to Figures 7a-7g, describes a process for generating a gap between the poles of the cladding, where the gap has dimensions less than a minimum feature size of a lithography process used to form the magnetic memory device. One skilled in the art understands that there are many suitable lithography processes, each lithography process having a corresponding minimum feature size. For a particular lithography process, the corresponding minimum feature size would be known to one skilled in the art. Accordingly, in light of the specification, one of ordinary skill in the art would understand what is claimed in the present application. Patent law does not require that all possible lithograph processes and their corresponding minimum feature sizes be listed in the patent, let alone listed in the claims. Rather, the claim must define the patentable subject matter with a reasonable degree of particularity and distinctness. Applicants respectfully submit that in the present application, the phrase “a distance that is less than a minimum feature size of a lithography process used to form the magnetic memory device” is as accurate as the subject matter permits and further defines the subject matter with the requisite degree of particularity and distinctness. Accordingly, withdrawal of the rejection of claims 47, 53 and 58 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Double Patenting

Claims 1, 2, 8, 9, 12-16, 19-21, 46-48, and 53-59 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,661,688.

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A Terminal Disclaimer in compliance with 37 CFR 1.321(c) is filed herewith. Accordingly, the double patenting rejection has been overcome, and withdrawal of the rejection of claims 1, 2, 8, 9, 12-16, 19-21, 46-48, and 53-59 is respectfully requested.

Allowable Subject Matter

Claims 10 and 11 are objected to as being dependent upon a rejected base claim (claim 1), but are indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As set forth above, with the filing of the Terminal Disclaimer in compliance with 37 CFR 1.321(c), independent claim 1 is now in allowable condition. Accordingly, dependent claims 10 and 11 are also in allowable condition, and notice to that effect is respectfully requested.

Claims 49-52 are indicated to be allowable over the art of record.

CONCLUSION

In light of the above, Applicant believes independent claims 1, 16, 46, 49, 53 and 54, and the claims depending therefrom, are in condition for allowance. Allowance of these claims is respectfully requested.

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Respectfully submitted,

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Attachments

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 24th day of May, 2004.

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